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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,784	08/06/2003	Makoto Kawaguchi	240886US3	7644
22850	7590	03/16/2006		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER KOEHLER, CHRISTOPHER M	
			ART UNIT	PAPER NUMBER
			3726	

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/634,784	Applicant(s) KAWAGUCHI ET AL.	
	Examiner Christopher M. Koehler	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 15 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 13 and 16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/5/04, 8/6/03</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in the reply filed on January 19, 2006 is acknowledged. The traversal is on the ground(s) that the apparatus and the method are not distinct. This is not found persuasive because the apparatus does not require the specific steps of the method of Group II, by way of example, the apparatus can apply stretch labels to a good without the need for a stretching ratio of the label not greater than 5%.

The requirement is still deemed proper and is therefore made FINAL.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the counter device as

set forth in claim 20 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Stretch Label Attaching Device.

6. The disclosure is objected to because of the following informalities: The continuing data given on page 16 of the specification should be listed in the first line of the specification in accordance with current U.S. practice.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 11 and 18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. The terms "elasticity" in claim 11 and "slidability" in claim 18 are relative terms which render the claims indefinite. The terms "elasticity" and "slidability" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-8, 10, 11, 14, 15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Snyder (US Patent No. 1,408,039).

12. Regarding claim 1, Snyder teaches a device for inserting a good into a stretchable medium comprising, an adaptor (b, figures 1-7) configured to support the stretchable medium (g) from an inside of the medium and having an opening into which the good (f) is inserted when attaching the medium on the good, an adaptor support member (a) configured to support the lower portion of the adapter and having an opening into which the good is inserted when attaching the stretchable medium on the good, and an adaptor fixing member (bolts/rivets) configured to fix the lower portion of the adapter together with the adaptor support member.

13. Regarding claim 2, Snyder teaches that the adaptor fixing members and the adaptor support member are engaged with each other with the adaptor therebetween.

14. Regarding claim 3, Snyder teaches the adapter fixing member and the adaptor support member fixedly support the adaptor while contacting at least one point of the adaptor.

15. Regarding claim 4, Snyder teaches that the adaptor support member contacting the adapter has a projected portion and a recessed portion. In figure 1 one can clearly see that the support member is projected away from the adaptor at the corners of the support member and recessed toward the adaptor at the midpoint between the corners of the support member. This is due to the round adaptor centered in the square support member.

16. Regarding claim 5, a length of the portion of the adaptor extending from the adaptor fixing member of Snyder is inherently capable of being shorter than the length of the stretchable medium. Snyder never limits the size of the stretchable medium and

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the apparatus is capable of performing the same function on a stretchable medium of varying sizes.

17. Regarding claim 6, Snyder teaches that the top of the adaptor is tapered.

18. Regarding claim 7, Snyder teaches that the adaptor has a notch (space between elements b) extending from the top to the bottom.

19. Regarding claim 8, Snyder teaches that the notch is formed such that an extension of the notch is perpendicular to a tangent line at a point of the bottom of the adaptor at which the extension of the notch meets the bottom of the adaptor.

20. Regarding claim 10, Snyder teaches that the notch extends so as to meet the adaptor fixing member when the adaptor is fixed by the adaptor fixing member and the adaptor support member.

21. Regarding claim 11, Snyder teaches that the adaptor has at least one of an extending/contracting property and an elasticity. Applicant should be made aware that even though Snyder meets the intention of the term "elasticity", the requirement of a material having an elasticity applies to all materials since all materials have a determinable elastic value. If it is intended to mean that the material is easily deformed and returns to its original dimensions with minimal deformation it should be stated.

22. Regarding claim 14, Snyder teaches that the good is inserted into the stretchable medium attaching device through the openings of the adaptor support member and the adaptor to an extent such that a bottom of the good (c) is level with the bottom of the adaptor support member and the stretchable medium occupies a predetermined attaching position of the good.

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23. Regarding claim 15, Snyder teaches that the outer surface of the adaptor has a slipping property higher than that of an inner surface of the stretchable medium.

24. Regarding claim 18, the adaptor support member of Snyder like all materials has a slidability. Whether the slidability is that substances slide easily or with great difficulty is irrelevant, i.e. both sandpaper and ice have a slidability.

25. Claims 1, 5, 7, 9 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall (US Patent No. 2,038,840).

26. Regarding claim 1, Hall teaches a device for inserting a good into a stretchable medium comprising, an adaptor (7, figure 8; 10, figure 9) configured to support the stretchable medium (8 figure 2) from an inside of the medium and having an opening into which the good (15 figure 4) is inserted when attaching the medium on the good, an adaptor support member (6) configured to support the lower portion of the adapter and having an opening into which the good is inserted when attaching the stretchable medium on the good, and an adaptor fixing member (6a) configured to fix the lower portion of the adapter together with the adaptor support member.

27. Regarding claim 5, Hall teaches that the stretchable medium is longer than the length of the adaptor extending from the adaptor fixing member.

28. Regarding claim 7, Hall teaches that the adaptor has a notch extending from the top toward the bottom (space between members 7, 10).

29. Regarding claim 9, Hall teaches that the tips of the adaptor (10) are curled inwardly.

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30. Regarding claim 18, the adaptor support member of Hall like all materials has a slidability. Whether the slidability is that substances slide easily or with great difficulty is irrelevant, i.e. both sandpaper and ice have a slidability.

Claim Rejections - 35 USC § 103

31. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

32. Claims 1 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Armstrong (US Patent No. 1,488,901) in view of Hall.

33. Regarding claim 1, Armstrong teaches a device for inserting a good into a stretchable medium comprising, an adaptor (1) configured to support the stretchable medium (G) from an inside of the medium and having an opening into which the good (S) is inserted when attaching the medium on the good, an adaptor support member (B) configured to support the lower portion of the adaptor, and an adaptor fixing member (4) configured to fix the lower portion of the adapter together with the adaptor support member. Armstrong does not teach that the adaptor support member has an opening through which the good is inserted into the stretchable medium. Hall teaches a device for inserting a good into a stretchable medium with similar structure to that of Armstrong with the exception that Hall teaches an opening in the adaptor support member through which the good is inserted into the adaptor. It would have been obvious to one of

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ordinary skill in the art at the time of invention to apply the opening teaching of Hall to the device of Armstrong in order to more easily and accurately place the good into the stretchable medium.

34. Regarding claim 17, Armstrong teaches that an inner surface of the adaptor support member has a projected portion and a recessed portion (figure 9).

35. Claims 12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall in view of Pilling et al (US Patent No. 6,049,960).

36. Regarding claim 12, Hall teaches the structure above but does not teach that the adaptor is polyethylene terephthalate film of 10-200 micrometers. Pilling teaches a device for inserting a good into a stretchable medium comprising a base (1) and adaptor members (2) and that the members are made of polyethylene of sufficient thickness (claim 9). It would have been obvious to one of ordinary skill in the art at the time of invention to apply the plastic composition of the adaptor in Pilling to the adaptor of Hall in order to make the adaptor more flexible, more cost effective, and easier to produce.

37. Regarding claim 19, Hall teaches the structure above but does not teach that the adaptor support member is polyethylene. Pilling teaches a device for inserting a good into a stretchable medium comprising a base (1) and adaptor members (2) and that the members and the base are made of polyethylene of sufficient thickness (claim 9). It would have been obvious to one of ordinary skill in the art at the time of invention to apply the plastic composition of the adaptor in Pilling to the adaptor of Hall in order to make the adaptor more flexible, more cost effective, and easier to produce.

38. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder. The examiner takes official notice that it was well known in the art of manufacturing at the time of invention to utilize counting devices to track the amount of products made without the need for the operator to keep track. Counting devices, in this way, allow the operators to focus on the machine as well as the quality of the product as manufacturing takes place.

Allowable Subject Matter

39. Claims 13 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

40. The following is a statement of reasons for the indication of allowable subject matter:

41. Regarding claim 13, the prior art fails to teach that the elasticity of the adaptor fixing member has a greater elasticity than the adaptor in combination with the requirements of the claim. Since the prior art does not teach the fixing member positioned within the opening of the adaptor there is no need for the fixing member to be more elastic.

42. Regarding claim 16, the prior art fails to teach that the inner surface of the adaptor support member has a slipping property higher than that of an outer of a good to which the stretchable medium is attached in combination with the requirements of the claim. Since the prior art does not teach the contact of the stretchable medium with the

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inside of the support member there is no need for the inside of the support member to have a higher slidability.

Conclusion

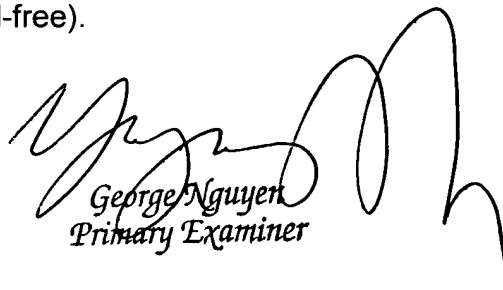
43. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Koehler whose telephone number is (571) 272-3560. The examiner can normally be reached on Mon.-Fri. 7:30A-4:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Nguyen can be reached on (571) 272-4491. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CMK


George Nguyen
Primary Examiner